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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/938,981	08/24/2001	Bradley J. Anderson	10006905-1	3325

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
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EXAMINER

GRANT II, JEROME

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 03/17/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/938,981

Applicant(s)

ANDERSON ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-32 is/are allowed.
- 6) ☒ Claim(s) 1-8, 10-16, 19 and 22 is/are rejected.
- 7) ☒ Claim(s) 17, 18, 20 and 21 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Detailed Action

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 10-13, 15, 16, 19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Koch.

cr With respect to claims 1 and 7, Koch teaches a method and a system for implementing the method (shown by figure 1) for scanning a medium (14), the system comprising: a first scanner (40) adapted to scan a first side of the medium 14 and detect one of a presence and an absence of a first image on the first side of the medium; and a second scanner 42 adapted to scan a second side of the medium and detect one of a presence and an absence of a second image on the second side of the medium (see also figure 4).

With respect to the new limitation added by amendment received Jan. 13, 2004, Koch teaches two signals from two scanners. The first signal travels through lead 56, shown by figure 4 and the second signal travels through lead 42, also shown by figure 4. Furthermore, Koch teaches at col. 5, lines 55-59 the proper detection of the absence and presence of a data mark by means of scanner 12. At col. 6, lines 17-24, the scanner 12 is composed of two scanners 40 and 42. Hence, the first and second scanners scan a first and second side of an object. Each of the scanners generated signals indicative of the respective scanning device. Both signals are then processed by unit 44 as shown by figure 4. .

With respect to claims 2 and 8, see col. 7, lines 1-10 where the first and second side are simultaneously scanned.

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With respect to claims 3 and 10, Koch teaches wherein, if the first scanner 40 detects the presence of the first image (control of enable signal 44 generated when a scan control signal is generated, note signal 56) and a second scanner (42) detects the absence of the second image (lack of enable signal due to no generation of scan control signal 54), the first scanner 40 is adapted to generate a first image signal and the second scanner 42 is adapted to generate a blank signal (when the enable signal 54 is not set). See also col. 11, line 22 to col. 12, line 10. Col. 5, lines 55-65 further teaches the generation of absence and presence data in an actual response area.

With respect to the new claim limitation added by amendment received Jan. 13, 2004, Koch anticipates this claim limitation. The first and second scanning devices, 40 and 42 respectively, generate signals mutually exclusive of the other scanner. Thus, if a mark (which is a type of image) is detected by the first scanner and an absence of a mark is detected by the second scanner, then respective signals will be generated by the scanners and processed by processing unit 44.

With respect to claims 4 and 11, Koch teaches this limitation. Note that without the enable signals 44 and 54, for the first and second sides, respectively, no image signals will be generated by the scan means 40 and 42 and blank signals will be generated.

With respect to the new claim limitation added by amendment received Jan. 13, 2004, Koch anticipates this claim limitation. The first and second scanning devices, 40 and 42 respectively, generate signals mutually exclusive of the other scanner. Thus, if a mark (which is a type of image) is detected by the first scanner and an absence of a mark is detected by the second scanner, then respective signals will be generated by the scanners and processed by processing unit 44.

With respect to claims 5 and 12, Koch teaches wherein if the scanner 40 detects the presence of the first image (via enable signal 44 having detected data marks 20 and the second scanner 42 detects the presence of the second image (data marks 22), the first scanner is adapted to generate a first image signal (enable signal plus the scan control signal 56) and the second scanner 42 is adapted to generate a second image signal (data marks 22 via enable signal 54).

With respect to the new claim limitation added by amendment received Jan. 13, 2004, Koch anticipates this claim limitation. The first and second scanning devices, 40

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and 42 respectively, generate signals mutually exclusive of the other scanner. Thus, if mark (which is a type of image) is detected by the first scanner and an absence of a mark is detected by the second scanner, then respective signals will be generated by the scanners and processed by processing unit 44.

With respect to claims 6 and 22, Koch teaches an automatic document feeder (onex, motors, solenoids, sensor etc, shown by figure 5) adapted to receive the medium 14 and position the medium between the first scanner and the second scanner (see fig. 4).

With respect to claim 13, Koch teaches wherein the step of scanning the first side of the medium includes scanning the first side (20) of the medium 14 with a first scanner 40, and wherein the step of scanning the second side 22 of the medium 14 includes scanning the second side of the medium with a second scanner 42 and further comprising the steps of: positioning the medium between the first scanner and the second scanner, see figure 4.

With respect to claim 14, Koch teaches a system for reproducing an image disposed on at least one of a first side and a second side of a medium, the system comprising: a first scanner 40 adapted to scan the first side 20 of the medium 14 and generate a first side data signal; a second scanner 42 adapted to scan the second side 22 of the medium 14 and generate a second side data signal; and a controller 44 adapted to receive the first side data signal and the second side data signal and generate an image reproduction data signal based on the first side data signal and the second side data signal, wherein, if the image is disposed only on the first side of the medium, the first side data signal includes a first image signal (enabled by signal 44) and the second side data signal includes a blank signal (disable signal 56), wherein the image reproduction data signal includes the first image signal and the blank signal.

With respect to the amendment received Jan. 13 2004, it is clear that scanners 40 and 42 read presence and absence of image data mutually exclusive of each other. See figure 4. Hence, one scanner may read an image while the other scanner reads an absence of image data. Both scanners will input the scanning result to the processor 44 for processing the absence and/or presence of image data.

With respect to claim 15, see col. 7, lines 1-10.

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With respect to claim 16, Koch teaches a reproduction unit (described by col. 2, lines 22-30) adapted to receive the image reproduction data signal and reproduce the image based on the image reproduction data signal, wherein the reproduction unit is adapted to reproduce the image based on the first image signal and, in response to the blank signal, discontinue reproduction of the image. Note, image data not detected on one side does not generate an enable signal 44, 54, hence, no reproduction of data will occur without the enable data.

With respect to claim 19, data is detected from the first and second sides of a medium as discussed, col. 6, lines 17-31. See col. 2, lines 22-30 when data detected on both sides of the medium are enabled from scanning and consequently for printing. Image data detected and scanned from both sides of the medium are recorded as described at col. 2, lines 22-30.

2.

Claims Objected

Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

3.

Claims Allowed

Claims 23-32 are allowed for the reason the prior art does not teach or suggest, "... wherein , if the image is disposed on the first side of the medium and the second side of the medium is blank, generating the first side data signal includes generating a first image signal and generating the second side data signal includes generating a blank signal, wherein generating the image reproduction data signal includes including the first image signal and the blank signal."

4.

Examiner's Remarks

Applicant's remarks have been considered but are unpersuasive to allow the claims.

Applicant argues that Koch does not teach or suggest a system for scanning a medium and generating data signals with respect to a first and second side. The same argument is applied to claim 7. The examiner strongly disagrees with applicant's contention.

Koch teaches reading the first and second side of a form 14. Koch further teaches that two scanners are used, 40 and 42. Each scanner reads a different side of the document 14. Each scanner sends its unique signal (via leads 56 and 54) to a processing circuit 44. Each of the scanners are responsible for generating signals indicating the presence of an image (mark) or the absence of the image, see col. 5, lines 55-59.

5.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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6.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II

JEROME GRANT II
PRIMARY EXAMINER